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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	Atty. Docket No.:	2391-002
Dale BURNS	Conf. No. :	9242
Appln. No.: 09/491,919	Group Art Unit:	2135
Filing Date: Jan. 27, 2000	Examiner:	Dada, Beemnet W.

For: **SYSTEM AND METHOD FOR EMAIL SCREENING**

REPLY BRIEF TRANSMITTAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed, please find:

1. Appellants' Reply Brief in response to the Examiner's Answer dated April 5, 2006.

The Commissioner for Patents is hereby authorized to charge all necessary fees or credit any overpayments to the Deposit Account No. 18-1579. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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(703) 391-2900



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For: **SYSTEM AND METHOD FOR EMAIL SCREENING**

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellants submit the following:

(i) *Real party in interest.*

The Examiner's Answer is correct in regard to the real party in interest.

(ii) *Related appeals and interferences.*

The Examiner's Answer is correct in regard to related appeals or interferences.

(iii) *Status of claims.*

The Examiner's Answer is correct in regard to the status of the claims.

(iv) *Status of amendments.*

The Examiner's Answer is correct in regard to the status of amendments.

(v) Summary of claimed subject matter.

The Examiner's Answer is correct in regard to the summary of claimed subject matter.

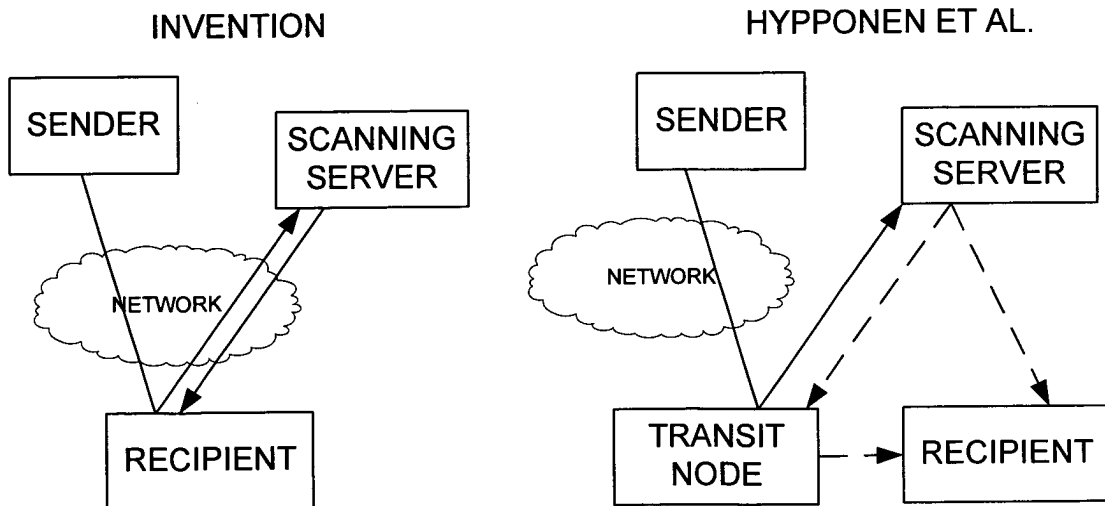
(vi) Grounds of rejection to be reviewed on appeal.

The Examiner's Answer has indicated the allowability of claims 5, 8, 9, 14 and 15, but has maintained the prior rejections as applied to the remaining claims. There are no new grounds of rejection and the Examiner's Answer is correct in regard to the remaining grounds of rejection to be reviewed on appeal.

(vii) Argument.

Background

The Examiner continues to disregard the fact that the presently-claimed invention requires *forwarding or re-routing* of email received at the recipient computer from the *recipient computer* to a *screening server*, as illustrated below. In contrast to this, the applied prior art ascribes to the interception method of email screening as done by ISPs or firewalls (i.e., transit nodes). One problem with the interception method of email screening is that it is not portable, i.e., it locks users into a particular Internet service (when provided by an ISP) or into a particular network location (when provided by a firewall). However, many email users have multiple email accounts from multiple services and access their various accounts from multiple locations.



Grounds I

In response to Appellants' arguments that Grounds I lacked a proper motivation to combine Council with Hypponen et al., the Examiner's Answer notes that "Council teaches a recipient computer connected to an email screening server" and points to paragraphs [0003], [0035]-[0036], and [0040]-[0041] of Hypponen et al. to allege that it discloses that a "received email message is redirected to a screening server..." However, no "received email" within the meaning of the claims is redirected in Hypponen et al. Indeed, claim 1 requires that the "recipient computer further comprises software instructions for forwarding all email messages received to the email screening server," which inherently requires that the "email messages received" be received *at the recipient computer*, not some other gateway node, prior to re-routing. Likewise, claim 10 requires "a recipient computer re-routing received email from the recipient computer to a screening server over a network," which inherently requires that the "received email" be received *at the recipient computer* prior to re-routing, not some other gateway node.

Hypponen et al. merely teaches the centralized screening of data at a *gateway node*, which is ordinarily done in the prior art. Paragraph [0003] states that the "advantage of this centralized approach is that the screening of data need be conducted only when data enters the network..." Paragraph [0035] limits the use of scanning software to "protected systems 4" which are defined in paragraph [0032] as firewalls, mail servers, proxy servers and database servers - *NOT* users/clients/workstations 2. Paragraph [0036] says that suspect data is "re-routed over the network 1, from the *protected system* in question, to the virus scanning server 7." This teaches away from having the *recipient computer* do the rerouting, as presently claimed. Paragraphs [0040] and [0041] discuss various modifications, but only mention that the scanning server 7 can send scanned data to "the destined user 2" instead of back to the protected system 4 (emphasizing that they are different) and mentions that systems 4 and servers 7 can viewed as applications and "be implemented on the same computer" as other server applications. It never suggests that a recipient computer can be a protected system.

While the Examiner's Answer has characterized the Appellants' arguments as referring to unclaimed features, Appellants respectfully submit that the discussed advantages are inherent in the claimed recipient computer's "*software instructions for forwarding all email messages*

*received to the email screening server” of claim 1, “software on a recipient computer rerouting email received by the email recipient computer to the email screening server over the network” of claim 6, and “a recipient computer re-routing received email from the recipient computer to a screening server over a network” of claim 10. Because the re-routing/forwarding is done (via software instructions) at the recipient computer, the invention inherently does not rely upon any particular ISP or gateway/firewall for the scanning. Applicants further note that the logic of the Examiner’s Answer regarding the argument that “the recipient computer can be connected to any network not just a protected one” is flawed since the present claims recite a network, but do not claim a protected system/firewall/gateway for intercepting suspect data that is *required* by Hypponen et al. (see, e.g., the “transit node” of claims 1 and 10 in Hypponen et al.).*

The Examiner’s Answer further appears to allege in multiple arguments that the mail server of Hypponen et al. can be a “recipient computer” required by the claims. Appellants submit that this position is not a “reasonable interpretation consistent with the specification” as required by MPEP 2111 since the specification repeatedly refers to redirection and scanning of an individual user’s email, not that of an organization or mail server. A mail server is not a recipient node, but only a transit node on the way to a recipient. Indeed, even Hypponen et al. clearly considers mail servers to be gateway-type *transit* nodes, not *user* nodes.

Council teaches interception of unauthorized email at an ISP or other transit nodes such as routers (see col. 3:37-41), but fails to suggest virus scanning. Hypponen et al. teaches interception at transit nodes for virus screening (see claims 1 and 10). Neither teach or suggest rerouting or forwarding of email *by a recipient computer* for scanning and/or authorization.

Grounds II

In discussing Grounds II of the rejection of claims 2-4 and 6-7, the Examiner’s Answer alleges multiple times that the mail server of Hypponen et al. can be a “recipient computer” required by the claims. Appellants again submit that this position is not a “reasonable interpretation consistent with the specification” as required by MPEP 2111.

The Examiner’s Answer also fails to address Appellants’ argument that the motivational statement “because such [authorization] list[s] are difficult to keep up” lacks any basis or foundation in the prior art. The Examiner’s Answer merely alleges that “Hardy teaches the use of

passwords as a means of authorization [Column 9, 15-17]” and that the “teachings of Hardy wherein passwords are used for authorization *can* be employed within [C]ouncil’s authorization list” (emphasis added). As a first matter, col. 9:15-17 of Hardy only teaches that the authorization server can send “information used to represent that server’s authorities to an appropriate third party, such as passwords to prove authorization to a password controlled database” and says nothing of using passwords to authorize delivery of a communication, let alone delivery of an email to a particular user without a fee. Additionally, in accordance with MPEP 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

With regard to the “impermissible hindsight” arguments, the Examiner’s Answer sets forth form paragraph 7.37.03, but fails to state how the rejection “takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure.” This is especially needed since Appellants have already argued that the motivational statement “because such [authorization] list[s] are difficult to keep up” lacks any basis or foundation in the prior art.


With respect to claim 3, the Examiner’s Answer erroneously argues that “holding all email message [sic] without password is included in the Council-Hypponen system...” However, Council discloses that if the sending party is not on the authorized list and has not authorized fees to be charged, “the message is simply *discarded*” (col. 2:2-7, emphasis added; see also: abstract, col. 2:43, col. 3:28-31, and claim 5). Clearly, holding ALL unauthorized email is not disclosed in Council, and Hypponen discloses the scanning of only suspect email (again, not ALL email).

Conclusion

For the above reasons, Appellants respectfully submit that the present claims meet the requirements of 35 U.S.C. 102 and 103 and that the Examiner has failed to make out a *prima facie* case of obviousness, and asks that the rejections be reversed.

Respectfully submitted,

ROBERTS MARDULA & WERTHEIM, LLC

A handwritten signature in black ink, appearing to read "Christopher B. Kilner". The signature is fluid and cursive, with the first name "Christopher" being more prominent than the last name "Kilner".

Christopher B. Kilner, Registration No. 45,381
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